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PATENT AND
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#15

In re Application of	:
Dinesh Patel et al	:
Serial No.: 09/738,859	: PETITION DECISION
Filed: December 13, 2000	:
Attorney Docket No.: 031740-005	:

This is a decision on the petition under 37 CFR 1.144, filed April 3, 2003, requesting review of a restriction requirement under 37 CFR 1.144. The delay in acting on this petition is regretted,.

BACKGROUND

A review of the file history shows that this application was filed under 35 U.S.C. 111. The examiner assigned to the application mailed a first Office action to applicants on April 8, 2002, setting forth a restriction requirement as follows:

Group I, claims 1-48, compounds of Formula I where Y is C or N, n is 2 or 3, and containing pyrazine, piperazine or benzodioxane as the only heterocycle substituent;
Group II, claims 1-48, compounds of Formula I where Y is C, n is 2 or 3, and containing pyrimidine or benzodioxane as the only heterocycle substituent;
Group III, claims 1-48, compounds of Formula I where Y is O, n is 3, and containing morpholine or benzodioxane as the only heterocycle substituent;
Group IV, claims 1-48, compounds of Formula I where Y is O or S, n is 2, and containing isoxale, thiazo or benzodioxane as the only heterocycle substituent;
Group V, claims 1-48, compounds of Formula I where Y is C, n is 2 or 3, and containing piperidine or benzodioxane as the only heterocycle substituent;
Group VI, claims 1-48, compounds of Formula I where Y is C, n is 1 or 2, and containing pyrrole or benzodioxane as the only heterocycle substituent;
Group VII, claims 1-48, compounds of Formula I where Y is N, n is 2, and containing imidazole or benzodioxane as the only heterocycle substituent

The examiner reasoned that there was no coercion between Groups I -VII and they are therefore independent and distinct. The examiner also indicated that if a compound was elected which did not fall within one of the groups that the examiner would build a generic concept from it.

Applicants replied on June 17, 2002, electing the compound of example 140 as the elected species, but could not determine which, if any, of the groups it was encompassed by. Applicants vigorously argued the restriction requirement and suggested that several of the Groups were overlapping in scope.

The examiner mailed a first action on the merits to applicants on July 19, 2002, maintaining the restriction requirement and responding to the traversal thereof and also indicating that the elected species did not fall within any of the Groups proposed. Claims 1-45 were held withdrawn from examination and claims 46-48 were rejected under 35 U.S.C. 112, second paragraph as indefinite. The examiner further suggested a subgenus based on the elected compound and suggested applicants amend their claims in accordance therewith in order for the application to be allowed.

A personal interview with the examiner was held on October 10, 2002, but no agreement was reached.

Applicants replied on December 19, 2002, including a two month extension of time request and fee therefor. Claims 1, 6-20, 25, 33-41 and 46-47 were amended, *inter alia*, to remove the rejection for indefiniteness. Applicants continued to argue the restriction requirement as improper for reasons similar to those set forth in the previous reply.

The examiner mailed a Final Office action to applicants on January 23, 2003, also indicating that the action was an ex parte Quayle action, setting a two month shortened statutory period for reply. The examiner continued to object to the inclusion of non-elected subject matter in the claims and required its cancellation.

Applicants then filed this petition regarding the restriction requirement as originally set forth as well as the examiner's requirements.

DISCUSSION

Applicants petition the examiner's restriction requirement on several grounds. Applicants argue that Groups I, II, V and VI overlap in scope as all require Y to be C, n to be 2 or 3 and include benzodioxane as the variables. Also, that Groups I and VII overlap where Y is N and the other variables are the same. Although no election of species within each group was required by the examiner, applicants elected a specific compound (Example 140) for prosecution. This compound did not fall within any of the Groups enumerated by the examiner thus providing some evidence that the original restriction requirement was flawed or incomplete. A possible reason that the elected compound did not fall within any of the groups is that all of the groups require n to be 2 or 3 (except Group VI, where it can be 1) and a review of the claims shows that at least 37 claims, i.e. - almost all of the dependent claims, assign a value of 1 to n. Thus almost all of the

Groups included only independent claims where n was assigned a value of other than 1.

Applicants further argue that the restriction is improper in that all of the compounds have the same core or backbone structure and that this structure is determinative of the compound's activity, not the additional variable added thereto. The only variable in the backbone, as acknowledged by applicants, is in the terminal ring which may have from 4-8 members with variable Y being C, N, O or S. Applicants indicate that they would not disagree with a restriction requirement based on such criteria (values of n and Y). However, the restriction requirement does not appear to have been based on such criteria, but on specific heterocyclic ring systems (variable R₇) which appear as variables attached to the core or backbone.

Applicants correctly point out that compounds within a Markush group must meet two criteria, (1) that they must share a common utility (the utility does not have to be claimed, only disclosed) and (2) that they must have a substantial structural feature in common. This substantial structural feature is the core or backbone portion of the compound and does not vary. Applicants point out that the examiner has argued that applicants claim numerous heterocyclic rings at position R₇ and that these determine classification and search of all of these classifications would constitute a serious burden on the examiner. However R₇ is not part of the core or backbone of the compound structure. Nor does it appear to be determinative of the compound's activity or utility. Thus the examiner's argument is not supportive of proper restriction practice.

Applicants also correctly point out (M.P.E.P. 803.02) that where a species is elected, as here, that species is examined fully and if found free of the prior art the examiner is required to extend the examination to additional related species. If all of the related species that are examined are found to be free of the prior art, then the claim, including all species encompassed thereby, is allowed. The examiner does not appear to have followed this guideline, but has examined the elected species, expanded the examination to additional species having specific heterocyclic substituents and then required applicant to limit the claims to that which has been examined. This is improper. In examining additional species related to the allowable elected species, a core or backbone common to all of the elected and related species should be determined and examination take place thereon. If this core is allowable, then all species having this core are allowable and no further limitation of the claims need be done. Applicants have indicated a willingness to limit the claims to only those compounds having the elected core or backbone of Example 140. Such amendment would be proper. That such species would be classified in various classes and subclasses based on other appended variables is immaterial.

Lastly, the Office action of January 23, 2003, indicates on the summary sheet that the Office action is a Final Office action and also indicates that it is an ex parte Quayle action. Such is inconsistent. Since there is no rejection, the action cannot be a Final action since there is no rejection to reply to. An ex parte Quayle action closes prosecution on the merits as all claims are allowable, but permits correction of formal matters, such as cancellation of non-elected claims. In this instance the examiner has required cancellation of portions of claims, thus indicating that those claims are not in allowable condition.


In view of the above it is concluded that the original restriction requirement set forth was both incomplete and improper in defining the restrictable groups. Restriction should have been based on the value of "n" and "Y" and not on the R₇ substituent. Such a requirement would have permitted assignment of the elected species to a specific group. As a consequence thereof, the examiner's Office action of April 8, 2002, and all subsequent Office actions are vacated.

DECISION

Applicants' petition under 37 CFR 1.144 is **GRANTED**.

The application will be forwarded to the examiner for the purpose of beginning prosecution anew by preparing a proper restriction requirement accompanied by an election of species requirement and indicate which group is elected based on the species which applicants have previously elected. The examiner will then conduct a proper examination on the merits of the elected species and on additional species if the elected species is found allowable.

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, PO BOX 1450, ALEXANDRIA, VA 22313-1450, or by telephone at (703)308-3824 or by facsimile transmission at (703) 305-7230.

 (for)
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